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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Olivier Attia

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SCANBUY, INC.
54 WEST 39TH STREET
FOURTH FLOOR
NEW YORK, NY 10018

EXAMINER

GART, MATTHEW S

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

10/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/883,933	Applicant(s) ATTIA, OLIVIER	
	Examiner Matthew S. Gart	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 6, 7, 9, 17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 6-7, 9, 17 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/15/2007 has been entered.

Prosecution History Summary

Claims 1-3, 5, 8, 10-16 and 18 have been cancelled.

Claims 4, 6-7, 9, 17 and 19 are currently pending and rejected below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 6-7, 9, 17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner notes, the phrase "Personalized Catalog" is not defined within the specification as originally filed. One of ordinary skill in the art would not have the ability to ascertain the meaning and scope of the term "Personalized Catalog." For examination purposes, the phrase "Personalized Catalogs" will be treated as a customized wish list.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6, 7, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (US 6,651,053 B1) in view of Walsh (6,144,848) and further in view of Knowlton (US 6,061,057).

Regarding claim 17 and related claim 4 and 19, Rothschild teaches a method for facilitating online ordering comprising the steps of: scanning a plurality of barcodes using a barcode scanner; uploading said barcodes into a centralized repository; Resolving each barcode into a product identifier using a product database located on said central repository; storing the resolved information in the repository in the form of customized shopping lists; creating personalized catalogs from said shopping lists instantly, wherein said personalized catalogs include product information of items within said shopping lists along with an associated barcode arranged such that said barcode is located in proximity of the product which it identifies, and wherein said personalized catalogs may be utilized to reorder items located in said catalog (see at least Abstract and Col 7, lines 22 – 38). Please note that Rothschild does not disclose shopping list.

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However, Rothschild does disclose wish list. In that regard, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Rothschild with the naming convention of shopping list too, which will increase the other application of the method as well as potentially increasing the revenue by being used in additional applications.

Although Rothschild's discloses UPC codes and searching, the reference does not specifically disclose and teach a method for recommending a product substitute to a consumer if the product is not found in said product database by querying internal and external repositories of product and manufacturer information based on Universal Product Codes'.

On the other hand and in the same area of online shopping using a portable device with bar code reader, Walsh teaches a method for recommending a product substitute to a consumer if the product is not found in said product database by querying internal and external repositories of product and manufacturer information based on Universal Product Codes (see at least Abstract, Col 3, lines 24 and 52 and Col 39, lines 46 – 54).

It would have been obvious to one of ordinary skill in the art to have provided the method of Rothschild with the method of Walsh to have enabled a method for facilitating online ordering comprising the steps of: scanning a plurality of barcodes using a barcode scanner; uploading said barcodes into a centralized repository; resolving each

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barcode into a product identifier using a product database located on said central repository; storing the resolved information in the repository in the form of customized shopping lists; creating personalized catalogs from said shopping lists instantly, wherein said personalized catalogs include product information of items within said shopping lists along with an associated barcode, wherein said personalized catalogs may be utilized to reorder items located in said catalog; and recommending a product substitute to a consumer if the product is not found in said product database by querying internal and external repositories of product and manufacturer information based on Universal Product Codes. Rothschild discloses a method for facilitating online ordering comprising the steps of: scanning a plurality of barcodes using a barcode scanner; uploading said barcodes into a centralized repository; resolving each barcode into a product identifier using a product database located on said central repository; storing the resolved information in the repository in the form of customized shopping lists; creating personalized catalogs from said shopping lists instantly wherein said personalized catalogs include product information of items within said shopping lists along with an associated barcode. wherein said personalized catalogs may be utilized to reorder items located in said catalog (see at least Abstract and Col 7, lines 22 – 38). In turn, Walsh discloses a method for recommending a product substitute to a consumer if the product is not found in said product database by querying internal and external repositories of product and manufacturer information based on Universal Product Codes (see at least Abstract, Col 3, lines 24 and 52 and Col 39, lines 46 – 54). Therefore, one of ordinary skill in the art would have been motivated to extend the method of

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Rothschild with a method for recommending a product substitute to a consumer if the product is not found in said product database by querying internal and external repositories of product and manufacturer information based on Universal Product Codes. In this manner, the added feature will provide additional products to order for the shopper, which will increase the probability for additional sales as well decreasing the time to search for substitute products.

The combination of Rothschild and Walsh disclose and teach substantially the applicant's invention.

However, the combination does not specifically disclose and teach a method for creating a shopping cart by dragging said shopping lists or items from said customized shopping lists and dropping them in said shopping cart; transferring said shopping cart to an e-commerce website; and using said e-commerce website to order said items located in said shopping cart.

On the other hand and in the same area of online shopping, Knowlton teaches a method for creating a shopping cart by dragging said shopping lists or items from said customized shopping lists and dropping them in said shopping cart; transferring said shopping cart to an e-commerce website; and using said e-commerce website to order said items located in said shopping cart (see at least Abstract, Col 15, lines 21 – 30 and 48 – 65).

It would have been obvious to one of ordinary skill in the art to have provided the combination of Rothschild and Walsh with the method of Knowlton to have enabled a method for creating a shopping cart by dragging said shopping lists or items from said customized shopping lists and dropping them in said shopping cart; transferring said shopping cart to an e-commerce website; and using said e-commerce website to order said items located in said shopping cart. The combination of Rothschild and Walsh discloses a method for shopping and creating a customized shopping/wish list by using a bar coded reader, uploading/storing the shopping/wish and creating a personalized catalog. Knowlton discloses a method for creating a shopping cart by dragging said shopping lists or items from said customized shopping lists and dropping them in said shopping cart; transferring said shopping cart to an e-commerce website; and using said e-commerce website to order said items located in said shopping cart (see at least Abstract, Col 3, lines 28 – 34, Col 15, lines 21 – 30 and 48 – 65). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Rothschild and Walsh with a method for creating a shopping cart by dragging said shopping lists or items from said customized shopping lists and dropping them in said shopping cart; transferring said shopping cart to an e-commerce website; and using said e-commerce website to order said items located in said shopping cart. In this manner, the retail merchant will increase the probability for additional sales from their mortar sites, which are now more effectively linked with their online site.

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Regarding Claim 6, Rothschild teaches a method for managing scan-based input, wherein said central repository is a server computer (Col 7, lines 23 – 24 and Col 8, line 18).

Regarding claim 7, the Examiner takes Official Notice that is old and well know that product database use relational databases.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Rothschild, Walsh and Knowlton as applied to claim 4 above, and further in view of Veeneman (US 5,774,674).

The combination of Rothschild, Walsh and Knowlton disclose and teach substantially the applicant's invention.

However, the combination does not specifically disclose and teach a method for managing scan-based input further including the step of: using billing information from a customer database to complete said online shopping.

On the other hand and regarding claim 9, Veeneman method for managing scan-based input further including the step of: using billing information from a customer database to complete said online shopping (Col 15, lines 53 – 59).

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It have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Rothschild, Walsh and Knowlton with the method of Veeneman to have enabled a method for managing scan-based input further including the step of: using billing information from a customer database to complete said online shopping. The combination discloses the claim language as recited in claim 17. In turn, Veeneman discloses a method for managing scan-based input further including the step of: using billing information from a customer database to complete said online shopping (Col 15, lines 53 – 59). Therefore, one of ordinary skill in the art would have been motivated to extend the combination with a method for managing scan-based input further including the step of: using billing information from a customer database to complete said online shopping.

Response to Arguments

Applicant's arguments with respect to the pending claims are not persuasive.

The Applicant argues that the phrase "Personalized Catalogs" has been argued and explained in Applicant's response to the September 27, 2005 office action.

The Examiner notes, it is the disclosure as originally filed which is reviewed to determine issues that relate to rejections under 35 U.S.C. 112, not office action responses. The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to ascertain the meaning and scope of the claimed invention.


Furthermore, the Applicant in the disclosure has not provided any special definition for the phrase "Personalized Catalogs." Therefore the term will be given is broadest reasonable interpretation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 571-272-6732. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

Matthew Gart
Primary Examiner
AU 3625